



Paper No. 23

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DIRECTOR OFFICE  
TECHNOLOGY CENTER 2100

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In re Application of: Seiki Aguro  
Application No. 09/281,042  
Filed: March 30, 1999  
For: COMPUTER SYSTEM

)  
) **DECISION ON PETITION UNDER 37**  
) **C.F.R. § 1.181(a) TO INVOKE**  
) **SUPERVISORY AUTHORITY**

This is a decision on a petition, filed 8 July 2002, under 37 C.F.R. § 1.181(a) to invoke Supervisory Authority and require the Examiner to (A) withdraw the comments regarding applicant's duty to disclose, and (B) to clarify his position as to whether IEEE Standard 1149.1 discloses applicant's invention.

The petition is **GRANTED**. The nature of the relief is indicated below .

**RECENT PROSECUTION BACKGROUND**

- October 24, 2000 - Office action mailed. Examiner states that "Applicant's invention has been disclosed as part of IEEE Standard 1149.1" and asks whether "Representative is aware of any other relevant prior art." Examiner does not reject over the standard, but cites it as "prior art made of record but not relied upon".
- March 26, 2001 - Petitioner files response amending claims and stating that "neither the inventor nor the undersigned attorney is aware of closer prior art which would be material to the examination of this application."
- June 18, 2001 - Final Office action mailed. Examiner repeats remarks of the previous Office action and adds a paragraph "remind[ing]" Applicant of the duty to disclose under 37 C.F.R. 1.56
- October 5, 2001 - Petitioner files IDS and Amendment under 37 C.F.R. 1.116
- March 5, 2002 - Petitioner files Appeal Brief
- June 3, 2002 - Examiner issues notice of Non-Compliance with 37 CFR 1.192(c)
- July 8, 2002 - New Appeal Brief and the instant petition are filed.

### RELIEF REQUESTED

The petition under 37 CFR § 1.181 requests the following relief:

- A. Withdrawal of the Rule 56 Requirement.
- B. Requiring the Examiner to clarify his position with respect to IEEE Standard 1149.1.

### OPINION

#### A. Rule 56 requirement

MPEP §2010 states in relevant part:

#### 2010 Office Handling of Duty of Disclosure/Inequitable Conduct Issues

.. the Office *does not investigate and reject* original or reissue applications under 37 CFR 1.56. Likewise, the *Office will not comment upon* duty of disclosure issues which are brought to the attention of the Office in original or reissue applications except to note in the application, in appropriate circumstances, that such issues are no longer considered by the Office during its examination of patent applications.

As the Office does not comment upon duty of disclosure issues brought to its attention, it follows *a fortiori* that it does not initiate or introduce such comments into an application. Examiner's original remarks may have been a misguided attempt to make a requirement under 37 C.F.R. § 1.105. However, when Applicant responded, specifically stating that neither the inventor nor the undersigned attorney is aware of closer prior art which would be material to the examination of this application." Applicant clearly met the requirements of 37 C.F.R. §1.56. As explained in MPEP 714.12(a) the threshold for disclosure of information under 37 C.F.R. §1.56 is substantially higher than for a request for information under 37 C.F.R. §1.105. The Examiner's repeated requirement in the face of Applicant's statement was inappropriate.

The Examiner is directed to explicitly withdraw this requirement in the next Office communication.

#### B. IEEE Standard 1149.1

The examiner has repeatedly implied that the cited standard anticipates the invention but has never made a rejection of record. From the record, it is not clear whether (i) the examiner believes that the claims as presented are distinguishable over the reference (alone or in combination with other prior art) or (ii) that the claims may be rejected over the reference, but that the Examiner refrained from

issuing a rejection because it would have been cumulative to or weaker than the rejections already of record.

This ambiguity places Applicant in the unenviable position of possibly prevailing upon appeal on the rejections of record while the aura of unpatentability over the non-applied reference remains.

### **DECISION**

The Petition is **GRANTED**.

The Examiner is directed to enter the Appeal Brief filed July 8, 2002 and to respond appropriately.

The following alternative courses of action would be deemed appropriate:

#### **(i) Art Rejection - Reopen Prosecution**

If a reasonable art rejection *of any claim* can be made based on the IEEE Standard 1149.1, then the Examiner is directed to make such rejection of record in unambiguous form and in clear detail. As this would constitute new grounds of rejection the Examiner would be required to reopen prosecution in the case. Examiner would be required to address arguments submitted in the appeal brief as in any amendment. (Note that the amendment filed October 5, 2001 was entered upon filing of the appeal brief). Furthermore, the Examiner is directed to address the IDS filed October 5, 2001 which has yet to be acknowledged and to specifically withdraw any requirement for applicant to file an IDS to comply with 37 C.F.R. §1.56.

#### **(ii) No Art Rejection Based Upon IEEE Standard 1149.1**

In the event that no art rejection is made employing IEEE Standard 1149.1 the Examiner shall specifically state so in the next action. The action shall clearly explain how the claims are distinguishable from the Standard and why no rejection is being applied.

##### **(a) Other New Grounds of Rejection - Reopen Prosecution**

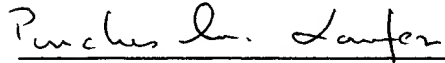
If other new grounds of rejection are entered Examiner would be required to reopen prosecution. Examiner would be required to address arguments submitted in the appeal brief as in any amendment. (Note that the amendment filed October 5, 2001 was entered upon filing of the appeal brief). Furthermore, the Examiner is directed to address the IDS filed October 5, 2001 which has yet to be acknowledged and to specifically withdraw any requirement for applicant to file an IDS to comply with 37 C.F.R. §1.56.

##### **(b) No New Grounds of Rejection - Issue an Examiner's Answer**

If no new grounds of rejection are entered Examiner may Issue an Examiner's Answer. As part of the Answer, the Examiner is directed to address the IDS filed October 5, 2001 which has yet to be acknowledged and to specifically withdraw any requirement for applicant to file an IDS to comply with 37 C.F.R. §1.56.

The application is hereby **REMANDED** to the Examiner to issue an appropriate action in compliance with the guidelines set out above.

Inquiries with respect to this decision may be directed to Pinchus M. Laufer at (703) 306-4160.



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